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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/797,765
Filing Date: March 10, 2004
Appellant(s): POYHONEN, PETTERI

Andrew T. Spence
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/10/2011 appealing from the Office action mailed 02/28/2011.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 20020064164 A1	Barany et al.	5-2002
US 20040156380 A1	Silverman et al.	8-2004

US 20050210292 A1

Adams et al.

9-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-4, 7-12, 14, 16-21, 23, 25-30, 32-39m 43-48, and 52-54** are rejected under 35 U.S.C. 102(b) as being anticipated by Barany et al. (US 20020064164 A1), hereafter "Barany."

Consider **claim 1**. Barany discloses:

An apparatus (**CSCF 40 in fig. 1; see [0023]**) comprising:

a processor (**see [0079]**); and

a memory including computer program code, the memory and computer program code configured to, with the processor (**see [0079], [0080]**), cause the apparatus to at least perform the following:

receiving a connection request via a network across which an originating client is configured to communicate (**see fig. 1, [0017], [0023]**); the CSCF module 40, within **wireless core network 11, is a SIP proxy or server that receives call requests on behalf of other entities, resolves logical addresses or identifiers in the call**

requests, and forwards the call requests to intended destinations also see

Abstract of present application);

preparing a network-independent trigger for transmission to a terminal in response to receiving the connection request (**see [0063]: trigger reads on INVITE, sent by the SIP proxy**); and

receiving a registration message, in response to the trigger, from the terminal via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity (**see [0062]: SIP registration is performed to set up the profile for the mobile station in the CSCF 40, so that the CSCF 40 is aware of the mobile station's existence**) of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal (**see [0023], [0062]-[0063], fig. 3**).

Consider **claim 2**. Barany teaches claim 1 and further suggests wherein receiving a connection request comprises receiving a connection request from the originating client, and wherein the memory and computer program code are further configured to, with the processor, cause the apparatus to further perform preparing the connection request for transmission to the terminal after registering the terminal (**see [0023], [0063], fig. 1**).

Consider **claim 3**. Barany teaches claim 2 and further suggests wherein preparing the connection request comprises preparing the connection request for transmission to the terminal through at least one other apparatus (**see fig. 1, [0023]: the CSCF module 40 is a (Session Initiation Protocol) SIP proxy or server that receives call**

requests on behalf of other entities, resolves logical addresses or identifiers in the call requests, and forwards the call requests to intended destinations; see also fig. 3 and [0064]: After all appropriate SIP messages have been exchanged, an RTP bearer path is established (at 114). In the RTP bearer path, IP packets containing RTP payloads are exchanged, hence suggesting transmission to the terminal through at least one other apparatus, the MGW –media gateway).

Consider **claims 4 and 14**. Barany teaches claims 1 and 10, and further discloses wherein the apparatus is embodied in a Session Initiation Protocol (SIP) proxy (see [0023]).

Consider **claims 7, 25, and 43**. Barany teaches claims 1, 19, and 37, and further suggests wherein receiving a registration message comprises receiving a subsequent registration message, and wherein the memory and computer program code are further configured to, with the processor, cause the apparatus to receive a first registration message from the terminal before preparing the network-independent trigger for transmission to thereby register the terminal with the apparatus, wherein the first registration message includes a network-independent identity of the terminal, and wherein preparing a network-independent trigger comprises preparing a network-independent trigger for transmission based upon the network-independent identity of the terminal (see [0023], [0062]–[0063]: trigger reads on INVITE, sent by the SIP proxy).

Consider **claims 8 and 26**. Barany teaches claims 1 and 19, and further suggests wherein preparing the network-independent trigger comprises preparing a network-independent trigger for transmission to the terminal via a network across which

an originating client is configured to at least one of directly or indirectly communicate (see figs. 1, 3, [0063]: *trigger* reads on INVITE, sent by the SIP proxy).

Consider **claims 9, 18, and 27**. Barany teaches claims 8, 17, and 26, and further discloses wherein the network comprises at least one of a public network or a private network (see fig. 1, [0003], [0022]).

Consider **claim 10**. Barany discloses:

An apparatus (**CSCF 40 in fig. 1; see [0023]**) comprising:

a processor (**see [0079]**); and

a memory including computer program code, the memory and computer program code configured to, with the processor (**see [0079], [0080]**), cause the apparatus to at least perform the following:

receiving a registration message via a network across which an originating client is configured to communicate, wherein receiving a registration message comprises receiving a registration message from a terminal to thereby register the terminal with the apparatus (**see [0023], [0062]-[0063]**), and wherein the registration message includes a network-independent identity of the terminal (**see [0023], [0063], fig. 1: Providing packet service in circuit-switched cellular networks, e.g., GSM (Global System for Mobile) networks, the General Packet Radio Service (GPRS) technology is used, see [0005], conjunctively with a SIP proxy, which registers the calling and called parties, handling the IP addresses required for packet switched communication; these IP address are independent of the circuit-switched cellular network, on**

behave of which the CSCF SIP proxy receives and handles those packet-switched call requests); and

preparing a network-independent trigger for transmission to the terminal based upon the network-independent identity of the terminal to thereby trigger the terminal to update registration of the terminal with the apparatus, including acquisition by the apparatus of a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal (**see [0023], [0062]-[0063]: trigger reads on INVITE, sent by the SIP proxy).**

Consider **claims 11 and 29**. Barany teaches claims 10 and 28, and further suggests receiving a connection request, the trigger being prepared for transmission in response to receiving the connection request and preparing the connection request for transmission to the terminal after acquiring the network-dependent identity of the terminal (see figs. 1 and 3, [0023], [0062]-[0063]: trigger reads on INVITE, sent by the SIP proxy; and, before reaching the SIP registration, the mobile sending the call request first goes through a routine network access process, well known in the art to include network identification, which implies acquiring a network-dependent identity of the apparatus to thereby enable establishment of a communication session with the apparatus based upon the network-dependent identity of the apparatus).

Consider **claims 12, 21, and 30**. Barany teaches claims 11, 20, and 29, and further suggests wherein preparing the connection request comprises preparing the connection request for transmission to the terminal through at least one other apparatus

(see figs. 1 and 3, [0023], [0062]-0063]: If the proxy apparatus of network 11 can receive/transmit a call request, it follows that said call request may be received/transmitted from/to a terminal communicating via another network similar to Network 11 in figure 1, where the call request is sent/received by another proxy similar to CSCF 40).

Consider **claims 16, 34, and 52**. Barany teaches claims 10, 28, 46, and further suggests wherein receiving a registration message comprises receiving a first registration message, and wherein the memory and computer program code are further configured to, with the processor, cause the apparatus to further receive a subsequent registration message from the terminal in response to the trigger being sent to the terminal to thereby update registration of the terminal and acquire the network-dependent identity of the terminal, thereby enabling establishment of a communication session with the terminal based upon the network-dependent identity of the terminal (see fig. 1, [0062]: SIP registration is performed to set up the profile for the mobile station in the CSCF 40, so that the CSCF 40 is aware of the mobile station's existence).

Consider **claims 17 and 35**. Barany teaches claims 10 and 28, and further suggests wherein receiving a registration message comprises receiving a registration message via a network across which an originating client is configured to at least one of directly or indirectly communicate (see figs. 1, 3, [0023]).

Claim 19 claims a method performed by the apparatus of claim 1; therefore, the same rejection rationale applies.

Consider **claim 20**. Barany teaches claim 19 and further suggests wherein receiving a connection request comprises receiving a connection request at the apparatus from the originating client, the method further comprising preparing the connection request for transmission to the terminal after registering the terminal (see [0023], [0063], fig. 1).

Consider **claim 23**. Barany teaches claim 19 and further suggests wherein preparing a trigger for transmission to the terminal comprises preparing a trigger for transmission to the terminal from an apparatus comprising a Session Initiation Protocol (SIP) proxy (see [0063]: trigger reads on INVITE, sent by the SIP proxy).

Claim 28 claims a method performed by the apparatus of claim 10; therefore, the same rejection rationale applies.

Consider **claim 32**. Barany teaches claim 28 and further suggests wherein receiving a registration message at an apparatus comprises receiving a registration message at an apparatus comprising a Session Initiation Protocol (SIP) proxy (see [0023], [0062]-[0063]).

Consider **claim 36**. Barany teaches claim 28 and further suggests wherein receiving a registration message comprises receiving a registration message apparatus via in a network comprising at least one of a public network or a private network (see fig. 1, [0003], [0022], [0023], [0062]-[0063]).

Consider **claim 37**. Barany discloses:

An apparatus (**CSCF 40 in fig. 1; see [0023]**) comprising:

a processor (**see [0079]**); and

a memory including computer program code, the memory and computer program code configured to, with the processor (**see [0079], [0080]**), cause the apparatus to at least perform the following:

receiving a trigger from another apparatus operating in a network across which an originating client is configured to communicate, the trigger comprising a network-independent trigger (**see [0063]: *trigger reads on INVITE, sent by the SIP proxy, hence independent from the circuit-switched network***); and

in response to the receiving the trigger, preparing a registration message for transmission to the other apparatus via the network to thereby register the apparatus with the other apparatus and acquire a network-dependent identity of the apparatus to thereby enable establishment of a communication session with the apparatus based upon the network-dependent identity of the apparatus (**see fig. 3, [0023], [0061]-[0063]: before reaching the SIP registration, the mobile sending the call request first goes through a routine network access process, well known in the art to include network identification, which implies acquiring a network-dependent identity of the apparatus to thereby enable establishment of a communication session with the apparatus based upon the network-dependent identity of the apparatus**).

Consider **claim 38**. Barany teaches claim 37 and further suggests wherein receiving a trigger comprises receiving a trigger in response to the other apparatus receiving a connection request from the originating client, and wherein the memory stores and computer program code are further configured to, with the processor, cause

the apparatus to further perform receiving the connection request from the other apparatus after registering the apparatus (see [0023], 0062), [0063]: If the proxy apparatus of network 11 can receive a call request, it follows that said call request may come from a terminal communicating via another network similar to Network 11 in figure 1, where the trigger is sent by another proxy similar to CSCF 40).

Consider **claims 39 and 48**. Barany teaches claims 38 and 47 and further suggests wherein receiving the connection request comprises receiving the connection request from the other apparatus via at least one further apparatus (see fig. 1 and [0023]: If the proxy apparatus of network 11 can receive a call request, it follows that said call request may come from a terminal communicating via another network similar to Network 11 in figure 1, where the trigger is sent by another proxy similar to CSCF 40).

Consider **claim 41**. Barany teaches claim 37 and further suggests wherein receiving a trigger comprises receiving a trigger from another apparatus comprising a Session Initiation Protocol (SIP) proxy (see [0063]: trigger reads on INVITE, sent by the SIP proxy. If the proxy apparatus of network 11 can receive a call request, it follows that said call request may come from a terminal communicating via another network similar to Network 11 in figure 1, where the trigger is sent by another proxy similar to CSCF 40).

Consider **claim 44**. Barany teaches claim 37 and further suggests wherein receiving a trigger comprises receiving a trigger from another apparatus operating in a network across which an originating client is configured to at least one of directly or

indirectly communicating (see [0062]-0063]: *trigger* reads on INVITE: If the proxy apparatus of network 11 can receive/transmit a call request, it follows that said call request may be received/transmitted from/to a terminal communicating via another network similar to Network 11 in figure 1, where the call request is sent/received by another proxy similar to CSCF 40).

Consider **claim 45**. Barany teaches claim 44 and further suggests wherein receiving a trigger comprises receiving a trigger from another apparatus operating in a network comprising at least one of a public network or private network (see fig. 1, [0003], [0022], [0063]: *trigger* reads on INVITE, sent by the SIP proxy. If the proxy apparatus of network 11 can receive a call request, it follows that said call request may come from a terminal communicating via another network similar to Network 11 in figure 1, where the trigger is sent by another proxy similar to CSCF 40).

Consider **claim 46**. Barany discloses:

An apparatus (**CSCF 40 in fig. 1; see [0023]**) comprising:

a processor (**see [0079]**); and

a memory including computer program code, the memory and computer program code configured to, with the processor (**see [0079], [0080]**), cause the apparatus to at least perform the following:

preparing a registration message for transmission to another apparatus operating in a network across which an originating client is configured to communicate, wherein preparing a registration message comprises preparing a registration message for transmission via the network to thereby register the apparatus with the other apparatus,

wherein the registration message includes a network-independent identity of the apparatus (see [0023], [0063], fig. 1: **Providing packet service in circuit-switched cellular networks, e.g., GSM (Global System for Mobile) networks, the General Packet Radio Service (GPRS) technology is used, see [0005], conjunctively with a SIP proxy, which registers the calling and called parties, handling the IP addresses required for packet switched communication; these IP address are independent of the circuit-switched cellular network, on behalf of which the CSCF SIP proxy receives and handles those packet-switched call requests**); and receiving a network-independent trigger based upon the network-independent identity of the apparatus to thereby trigger the apparatus to update registration of the apparatus with the other apparatus, including acquisition of a network-dependent identity of the apparatus to thereby enable establishment of a communication session with the apparatus based upon the network-dependent identity of the apparatus (see [0023], [0062]-[0063]: **trigger reads on INVITE, sent by the SIP proxy, hence independent from the circuit-switched network**).

Consider **claim 47**. Barany teaches claim 46 and further suggests wherein receiving a network-independent trigger comprises receiving a network-independent trigger in response to the other apparatus receiving a connection request from the originating client, and wherein the memory and computer program code are further configured to, with the processor, cause the apparatus to further perform receiving the connection request from the other apparatus after registering the apparatus with the other apparatus (see [0023], [0062]-[0063]: **trigger reads on INVITE, sent by the SIP**

proxy, hence independent from the circuit-switched network. If the proxy apparatus of network 11 can receive/transmit a call request, it follows that said call request may be received/transmitted from/to a terminal communicating via another network similar to Network 11 in figure 1, where the call request is sent/received by another proxy similar to CSCF 40).

Consider **claim 50**. Barany teaches claim 46 and further suggests wherein preparing a registration message comprises preparing a registration message for transmission to another apparatus comprising a Session Initiation Protocol (SIP) proxy (see [0062]-0063]: If the proxy apparatus of network 11 can receive/transmit a call request, it follows that said call request may be received/transmitted from/to a terminal communicating via another network similar to Network 11 in figure 1, where the call request is sent/received by another proxy similar to CSCF 40).

Consider **claim 53**. Barany teaches claim 46 and further suggests wherein preparing a registration message comprises preparing a registration message for transmission to another apparatus operating in a network across which an originating client is configured to at least one of directly or indirectly communicate (see [0062]-0063]: If the proxy apparatus of network 11 can receive/transmit a call request, it follows that said call request may be received/transmitted from/to a terminal communicating via another network similar to Network 11 in figure 1, where the call request is sent/received by another proxy similar to CSCF 40).

Consider **claim 54**. Barany teaches claim 46 and further suggests wherein preparing a registration message comprises preparing a registration message for

transmission to another apparatus operating in a network comprising at least one of a public network or a private network (see fig. 1, [0003], [0022], [0062]-0063]: If the proxy apparatus of network 11 can receive/transmit a call request, it follows that said call request may be received/transmitted from/to a terminal communicating via another network similar to Network 11 in figure 1, where the call request is sent/received by another proxy similar to CSCF 40).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims **5, 13, 22, 31, 40 and 49** rejected under 35 U.S.C. 103(a) as being unpatentable over Barany et al. (US 20020064164 A1), hereafter "Barany," in view of Silverman et al. (US 20040156380 A1), hereafter "Silverman."

Consider **claims 5, 13, 22, 31, 40 and 49**. Barany teaches claims 1, 11, 20, 29, 38, and 47 and further suggests receiving a connection request and preparing the

connection request for transmission to the terminal based upon the network-dependent identity of the terminal (see fig. 3, [0023], [0061]-[0063]: before reaching the SIP registration, the mobile sending the call request first goes through a routine network access process, well known in the art to include network identification, which implies acquiring a network-dependent identity of the apparatus to thereby enable establishment of a communication session with the apparatus based upon the network-dependent identity of the apparatus), but is silent regarding causing the connection request to be stored/retrieve in/from a buffer. Silverman, in analogous art, suggests the aforesaid limitation about which Barany is silent (see Abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate Silverman's teachings regarding causing the connection request to be stored/retrieve in/from a buffer in Barany's invention for the purpose of providing users preference in establishing and conducting VoIP calls by: (i) assigning precedence (a classmark) to calls, as discussed by Silverman (see [0012])).

6. Claims **6, 15, 24, 33, 42, and 51** rejected under 35 U.S.C. 103(a) as being unpatentable over Barany et al. (US 20020064164 A1), hereafter "Barany," in view of Adams et al. (US 20050210292 A1), hereafter "Adams."

Consider **claims 6, 15, 24, 33, 42, and 51**. Barany teaches claims 1, 10, 19, 28, 37, and 46; but is silent regarding receiving registration messages from the terminal via at least one of a network address translator (NAT) or a firewall (FW) operating between the apparatus and the terminal, and wherein preparing a network-independent trigger

comprises preparing a network- independent trigger for transmission in a manner independent of the at least one of the NAT or FW. However, Adams, in analogous art, suggests the aforesaid limitation (see [0098]). Therefore, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to incorporate Adam's teachings in Barany's invention, thus enabling clients to traverse firewall and NAT installations, as discussed by Adams (see [0003]).

(10) Response to Argument

Read in light of the specifications, the present application, as per independent claims 1, 10, 19, 28, 37, and 46, claims apparatus and method for **receiving a connection request** *via a network across which an originating client is configured to communicate*; **prepare a network-independent trigger for transmission to a terminal in response to receipt of the connection request**; and **receive a registration message, in response to the trigger, from the terminal via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal.**

The Appellant's underlining argument is that Barany does not disclose the invention recited in the aforesaid claims, and presents an argument to the issues identified by the Examiner in the Appellant's response submitted in Amendment After-Final filed on 02/08/2011, which is reproduced below, as stated on Advisory Action mailed on 02/28/2011:

Applicant's arguments in After-Final Amendment filed on 02/08/2011 have been fully considered, but are not persuasive. The aforesaid arguments summarize to the issue that Barany does not teach or suggests an apparatus being caused to prepare a network-independent trigger for transmission to a terminal in response to receipt of connection request, the apparatus being caused to receive a registration message, in response to the network-independent trigger, via the network to thereby register the terminal with the apparatus and acquire a network-independent identity of the terminal.

In response, it is worth noting that the claimed invention's specifications define the apparatus of claim 1 as a SIP proxy (see Abstract and [0013]). Then, it is also worth remarking that, according to claim 1, what is basically being claimed is an SIP proxy, which, needless to say, comprises a processor (no further explanation is required for a person ordinarily skilled in the art to admit that a processor is inherent to electronic communications devices).

The claim further recites that said apparatus is configured to receive a connection request from an originating client terminal, sending a network-independent trigger to a terminal, and performing registration for said terminal in order to be able to establish a communication session.

Aside from the intended use of the claimed apparatus (See MPEP 2113), i.e., configured to perform the particular functions described in the claim, the statement receiving the connection request via a network does not amount to any novelty weight for the invention, since communications sessions are necessarily realized via at least a network.

Network independent-trigger or registration is understood by said functions being performed by the SIP proxy node, not by part of the network to which those functions are normally assigned, e.g., an MSC (mobile switching center), or HLR (home location register), or VLR (visitor location register).

It is clear that Barany discloses an apparatus specified as an SIP proxy that receives call requests, performs registration, and sends a trigger to a terminal, e.g., invites other terminals (see [0023] and [0062]), regardless of the intended use.

As a result, the argued features are written such that they read upon the cited references.

The examiner maintains his position as expressed on the cited Advisory Action, given the fact that Barany does disclose the structural element of the claimed invention, e.g., a proxy that receives call requests from an originating terminal, performs registration for said originating terminal and INVITES other terminal, from what follows that since the CSCF module 40, which is a (Session Initiation Protocol) SIP proxy or server, is capable of receiving call requests on behalf of other entities, and also has the capability of inviting users for communication sessions, it follows that the call request it received is intended for a user which it is capable of inviting, which is shown in [0023], thus inherently disclosing the argued feature and the limitations of the aforementioned independent claims. (see also page 19 lines 30-30 through page 20 lines 1-12 of present application's specifications).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/A. G./
Examiner, Art Unit 2617
August 25, 2011

Conferees:

/Dwayne Bost/
Supervisory Patent Examiner,
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/George Eng/
Supervisory Patent Examiner, Art Unit 2617